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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,419	03/01/2002	Dieter Dohring	616.95USWO	2940
23552	7590	11/03/2004	EXAMINER	
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			WATKINS III, WILLIAM P	
			ART UNIT	PAPER NUMBER
			1772	
DATE MAILED: 11/03/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/980,419

Applicant(s)

DOHRING ET AL.

TH

Examiner

William P. Watkins III

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-12 and 14-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-12 and 14-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 17 August 2004 has been entered. The examiner notes that the petition to revive, filed 17 August 2004, was granted in a paper mailed 03 September 2004

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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3. Claims 1, 3-12, 14-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jaisle et al. (U.S. 4,473,613) in view of Moroff et al. (U.S. 3,853,594).

Jaisle et al. teaches the formation of a decorative laminate using an acrylic resin and a melamine resin and abrasive particles (col. 2, lines 55-65), that are pressed and impregnated into the décor sheet of a core (carrier) and décor sheet laminate by a belt press or other means (col. 7, lines 25-35, col. 5, lines 20-35). The weight of the paper in the décor sheet can be between 16 and 160 grams per square meter (col. 4, lines 35-40). Moroff et al. teaches using a roller to impregnate a composite décor sheet (col. 2, lines 10-25). The instant invention claims a method of making a paper décor sheet that involves the rolling an acrylic solution into the paper layer of a décor panel. It would have been obvious to one of ordinary skill in the art to substitute nip rollers for the belt presses of Jaisle et al. as they serve the same function of impregnating a resin solution into the paper.

4. Claims 11-12, 14-18, 26-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jaisle et al. (U.S. 4,473,613).

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The reference as noted above teaches a paper with an acrylic resin impregnation. The instant invention is to a paper with an acrylate impregnation. It would have been obvious to one of ordinary skill in the art to have selected the acrylic resin option from those taught by Jaisle et al. in order to form a specific décor sheet. In this rejection no weight is given to the process of rolling in the acrylic.

5. Claims 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jaisle et al. (U.S.. 4,473,613) as applied to claims 1, 3-12, 14-30 above, and further in view of applicant's admission of the state of the art at page 1, lines 15-20.

Applicant admits that tiles are formed by decorative overlays on core or carrier layers and that counter pull layers are conventional to counter balance the decorative décor layer. The instant invention claims an acrylate resin impregnated into a décor layer, which is to form a tile laminate. It would have been obvious to one of ordinary skill of the art to have added a counter pull layer to the core and décor layer of Jaisle et al. in order to stabilize the decorative laminate.

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6. Claims 1, 3-12, 14-32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

It is not clear where the instant specification supports the 15 to 60 grams per square meter basis weight of the paper, as now claimed, as being the weight after impregnation.

7. Applicant's arguments filed 17 August 2004 have been fully considered but they are not persuasive.

Applicant argues that the acrylic resin of Jaisle et al. is not equivalent to the acrylate resin that is instantly claimed. This argument is not well founded. The acrylic resin of Jaisle et al. is disclosed as comprised of various acrylates (col. 3, lines 30-40). Applicant also argues that the weight of the instant claimed paper is with resin, while the paper weight of Jaisle et al. is without resin. As noted in the 112 new matter rejection above, it is not clear where the instant specification teaches that the disclosed paper weight is after impregnation.

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The instant impregnated paper is not taught as having any specific tear resistance and is thus taken as having a similar tear resistance to that of the paper of Jaisle et al., which is impregnated with a similar resin.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Watkins III whose telephone number is 703-308-2420. The examiner works an increased flex time schedule, but can normally be reached Monday through Friday, 11:30 A.M. through 8:00 P.M. Eastern Time. The examiner returns all calls within one business day unless an extended absence is noted on his voice mail greeting.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 703-308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.



WW/ww

November 1, 2004

**WILLIAM P. WATKINS III
PRIMARY EXAMINER**